

skilled in the art would have been motivated to provide a hypothetical combination in the manner claimed. The Examiner is reminded that an obviousness rejection requires a specific showing as to why one of ordinary skill in the art would have selected the components for combination in the manner claimed.<sup>1</sup> “The examiner’s conclusory statements ... do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and [cannot] be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[use] that which the inventor taught against its teacher.’” *In re Lee*, 61 USPQ2d at 1434 (quoting *W.L. Gore v. Garlock, Inc.*, 202 USPQ 303, 312-13 (Fed. Cir. 1983)).

Each of the independent claims 1, 12, 19, and 30 specify a server (e.g., 14 of Fig. 1) attempting retrieval of a subscriber announcement from a messaging server (e.g., 16 of Fig. 1), where the subscriber announcement (e.g., 20 of Fig. 1) is stored in the messaging server as a first data file having a first size. Each of the independent claims also specify retrieving an audible subscriber identifier (e.g., 26 of Fig. 1), stored in the *directory* server (e.g., 22 of Fig. 1), and playing for the messaging session an alternate subscriber announcement having the audible subscriber identifier, based on a determined *inaccessibility* (see, e.g., page 6, line 27 to page 7, line 2; page 8, lines 8-12; page 9, lines 17-26; page 10, lines 8-10) of the stored subscriber announcement (e.g., 20 of Fig. 1).

Hence, each of the independent claims explicitly specify that the audible subscriber identifier is retrieved from the directory server based on the determined *inaccessibility* of the subscriber announcement that is *stored in the messaging server*; consequently, the audible

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<sup>1</sup>*Cf. In re Lee*, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (quoting *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998) (“the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” (emphasis added))).

subscriber identifier is played as part of an “*alternate* subscriber announcement” (see, e.g., page 5, lines 13-15). These and other features are neither disclosed nor suggested in the applied prior art.

**Bates et al.**

The Examiner is applying an unreasonable interpretation of Bates et al. and disregarding explicit claim limitations. In particular, the Examiner cites in para. 14 (pp. 3-4) and 19 (pp.5-6) the **switch 40** of Fig. 1 as a purported teaching of the claimed *server* that performs: (1) “attempting *retrieval* of a subscriber announcement ... from a *messaging server* ... based on the subscriber profile information (see Feb. 6, 2006 Office Action at page 4, para. 12, lines 3-7); (2) “determining an inaccessibility [sic, should be availability as applied to Bates] of the subscriber announcement for the messaging session from the messaging server” (see Feb. 6, 2006 Office Action at page 4, para. 12, lines 9-11, citing Bates at col. 7, lines 13-16); and (3) “playing for the messaging session an alternate subscriber announcement including the audible subscriber identifier” (see Feb. 6, 2006 Office Action at page 5, para. 12, lines 16-18).

In fact, the disclosed **switch 40** performs *none* of the claimed operations, because it does nothing more than **connect the voice messaging system (VMS) 10 to the telecommunication terminals 42:**

As depicted, a voice messaging system s (VMS) 10 is connected to a **switching system 40 that enables communication between subscriber and caller telecommunication terminals 42a-42n**. Subscriber and caller telecommunication terminals 42a-42n may include multiple types of telecommunication terminals including, but not limited to, standard telephone systems, modems, cellular telephones, pagers, etc. In addition, switching system 40 may be part of a telecommunications network 46 that may include other telecommunication terminals, other switching systems, and other messaging systems, such as VMS 44.

(Col. 3, line 67 to col. 4, line 11).

Bates et al. provides *no other teaching whatsoever* as to the operations of the switching system 40. In fact, all other teachings relied on by the Examiner (e.g., the subscriber profiles 24,

the operations at col. 7, lines 8-18) are performed solely in the VMS 10, and not the switch 40, as asserted by the Examiner. Hence, the switch 40 provides no other function other than to connect the terminals 42 to the VMS system.

Hence, Bates et al. provides no disclosure or suggestion of the claimed *server* that: (1) *attempts retrieval* of a subscriber announcement for the messaging session *from a messaging server* based on the subscriber profile information (accessed from the directory server), (2) determines an “unavailability” of the subscriber announcement for the messaging session from the messaging server (as relevant to the overall hypothetical combination and the teachings of Krusei, discussed *infra*), or (3) *plays* for the messaging session an alternate subscriber announcement.

For this reason alone the §103 rejection must be withdrawn because Bates et al. fails to disclose or suggest the features, as asserted by the Examiner. “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. MPEP §2141.02, page 2100-132 (Rev. 3, Aug. 2005) (*citing W.L. Gore & Assoc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984))(emphasis in original).

Further, Applicant traverses the Final Action as incomplete because it fails to answer the material traversed.<sup>2</sup> Specifically, the Examiner mischaracterized Applicant’s “Argument 3” on page 4 as “Bates does not disclose the features of claim 1 because he does not disclose ‘determining an inaccessibility of the subscriber announcement’ as recited in claim 1.” In fact, Applicant argued on page 13 as follows:

Applicant further traverses the Examiner’s assertion in para. 9 that “Bates states the ability of his system to retrieve a default message and play this message *when a first particular greeting is unavailable*”, because the Examiner’s assertion improperly assumes the existence of the “first particular greeting” for the calling party, and that the default message is retrieved when the first particular greeting is “unavailable”.

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<sup>2</sup>See MPEP §707.07(f) “Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.”

(Amendment filed May 8, 2006, page 13) (emphasis in original).

The Examiner fails to address this argument and continues to distort the teachings of Bates by misleading with the statement that the “first particular greeting” is retrieved “*when* a first particular greeting is *unavailable*”: this statement, however, implies the unfounded premise that the “first particular greeting” already exists.

In fact, Bates et al. does not teach using a default greeting “when a first particular greeting is unavailable” (implying the existence of the first particular greeting) as asserted by the Examiner, but use of a default greeting **when the “first particular greeting” does not exist!** Bates et al. teaches that a default greeting (Announcement number “5”) is used for any instance where a positive association to one of the context-specific greetings has not been established (see, e.g., Table 1 and column 4, lines 53-55: “Announcement number “5” refers to a standard greeting announcement that is a default for unknown caller Ids.”). Figure 2 of Bates et al. also describes selecting the default greeting **not** based on unavailability of a **stored** greeting, but rather based on whether one of the existing pre-recorded readings is designated for the incoming call based on the caller ID (see col. 7, lines 8-22 quoted on page 14 of the Amendment filed May 8, 2006).

Hence, Bates et al neither discloses nor suggests determining an availability of the **stored subscriber announcement**, because Bates et al. assumes all stored announcements are available on the disk memory 30.

Applicant also strenuously objects to the gross mischaracterization in para. 18 (on page 5 of the July 18, 2006 Final Rejection) of Applicant’s argument as specified in footnote 2 on page 14 of the Amendment filed May 8, 2006: the “inaccessibility” (or even *unavailability*) is not with respect to the node **accessing** the stored file from the messaging server, but the “inaccessibility” or “unavailability” of the subscriber announcement “***from the messaging server***” due to the inoperability of the *messaging server*.

In other words, Bates et al. fails to disclose or suggest the feature as *asserted by the Examiner* of determining an unavailability of the subscriber announcement for the messaging

session from the messaging server (see Feb. 6, 2006 Office Action at page 4, para. 12, lines 9-11; 3-15-05 at page 4, para. 12, lines 9-11).

Hence, the rejection is improper because, on the one hand, the Examiner *continues* to assert that Bates discloses determining an “unavailability” of the subscriber announcement, but then evades Applicant’s traversals by asserting the specious argument that “one cannot show nonobviousness by attacking references individually” (see July 18, 2006 Final Action at p. 6, para. 20).

In fact, the absence of any teaching of the claimed “determining an inaccessibility of the subscriber announcement ... *from the messaging server*”, wherein the claims also specify that the messaging server stores the subscriber announcement, *is* in fact relevant to an obviousness evaluation, especially since none of the applied references, singly or in combination, address the possible *unavailability* of the messaging server that renders *inaccessible* the subscriber announcement that is stored on the messaging server. An evaluation of obviousness must be undertaken from the perspective of one of ordinary skill in the art addressing the same problems addressed by the applicant in arriving at the claimed invention. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve*, 23 USPQ 416, 420 (Fed. Cir. 1986), *cert. denied*, 484 US 823 (1987). Thus, the claimed structures and methods cannot be divorced from the problems addressed by the inventor and the benefits resulting from the claimed invention. *In re Newell*, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

For these and other reasons, the §103 rejection must be withdrawn

**Fuller et al.**

Applicant again strenuously traverses the Office Action as incomplete for failing to address the substance of all matter traversed: Applicant did not argue that Fuller does not disclose retrieving a default announcement “based on the determined inaccessibility”, as asserted as “Argument 4” on page 4 of the Final Action.

Once again, the Examiner is evading his own assertions as to the teachings of Fuller:

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retrieving from the directory server an audible subscriber identifier, stored in the directory server as a second data file having a second size substantially smaller than the first size, based on the *determined inaccessibility* [sic] of the subscriber announcement (**Fuller, column 25, line 63 through column 26, line 2, where the “drop-in name” is substantially smaller than the greetings of Bates, table 1**)

(Feb. 6, 2006 Office Action, pp. 4-5, para. 12 at lines 12-16).

In fact, the Examiner disregards the qualifiers by Applicant on page 15 of the Amendment filed May 8, 2006 that the arguments were equally applicable if the claims specified “inaccessibility” or “unavailability”.

As *previously argued*, Fuller does not disclose or suggest retrieving the default announcement based on the “unavailability” of the **stored subscriber announcement**; rather, Fuller explicitly describes with respect to Figs. 7 and 12b that the **standard greeting type 704** is retrieved in step 1236 of Fig. 12b from the subscriber master record of Fig. 7: the standard greeting type 704 of Fig. 7 “defines the courtesy greeting announcement which the ***subscriber has selected*** for the Telephone Control System 1 to use when first answering a call” (col. 20, lines 19-23). The call processing facility 100 determines from the standard greeting type 704 whether **the retrieved greeting** is a “stock” greeting (step 1237), a “drop in” greeting (step 1240), or a “personalized” greeting (step 1245) (col. 25, lines 54-56 and 59-65 and col. 26, lines 6-12).

Hence, the type of greeting to use in Fuller et al. is ***selected by the user*** as specified by the standard greeting type 704, and **not based on any determined unavailability of any stored data**.

Moreover, Fuller et al. explicitly teaches that **both** the “drop in” greeting (step 1240) and the “personalized” greeting (step 1245) are retrieved from the **same source**, namely disk 505 in the call processing facility 100 of Fig. 5, because **all** subscriber master records are stored on the disk 505 (col. 20, lines 1-2; col. 25, lines 62-65; col. 26, lines 6-12). Hence, Fuller et al. provides the same storage arrangement as Bates et al., where **all subscriber announcements are**

stored on the same disk internal to the voice messaging system (10 of Bates et al., 100 of Fuller et al.).

### **Bates in Combination with Fuller**

As admitted in the Official Action, “Bates and Fuller did not explicitly disclose determining an inaccessibility of the subscriber announcement.” In fact, both Bates and Fuller teach away from the claimed features by storing all announcements and all data on **a single storage device**.

Bates et al. teaches that all of the greetings (including the default greeting) utilized by a subscriber are stored in the same disk memory 30 in the VMS 10 of Figure 1 (column 4, lines 21-30). Consequently, if for some reason (e.g., a failure of the disk memory 30) the disk memory 30 was no longer available, then the VMS 10 would ***no longer be able to present any greeting for an incoming call***.

Fuller et al. explicitly teaches that **both** the “drop in” greeting (step 1240) and the “personalized” greeting (step 1245) are retrieved from the same source, namely disk 505 in the call processing facility 100 of Fig. 5, because all subscriber master records are stored on the disk 505 (col. 20, lines 1-2; col. 25, lines 62-65; col. 26, lines 6-12). Hence, Fuller et al. provides the same storage arrangement as Bates et al., where all subscriber announcements are stored on the same disk internal to the voice messaging system (10 of Bates et al., 100 of Fuller et al.). Consequently, if for some reason (e.g., a failure of the disk memory 505) the disk memory 505 was no longer available, then the call processing facility 100 of Fig. 5 would ***no longer be able to present any greeting for an incoming call***.

Given the foregoing, the burden is on the Examiner to demonstrate that one having ordinary skill in the art would have been motivated to modify the hypothetical combination of Bates et al. and Fuller to include the teachings of Kruesi et al.<sup>3</sup> Further, the burden is on the

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<sup>3</sup>“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability

Examiner to demonstrate specifically that one skilled in the art would modified the combination of Bates et al. and Fuller in the manner claimed.<sup>4</sup>

As demonstrated below, there is no motivation demonstrated for skilled in the art to modify Bates in combination with Fuller in order to provide a *server* configured for playing an alternate subscriber announcement *for a messaging session* retrieved from a *directory server* based on a determined inaccessibility of the subscriber announcement *stored in the messaging server for a messaging session*.

### **Kruesi et al**

The Examiner fails to dispute Applicant's assertions as to the teachings Kruesi et al. as argued on pages 11-12, and as such concedes that Kruesi et al. uses different servers to access the same data from the same storage location by asserting in para. 16 on page 5 of the Final Action that "Kruesi's system clearly determines an inaccessibility of a voice file at a certain node."

However, the Examiner demonstrates a deliberate disregard of explicit claim limitations by asserting in para. 17 (page 5) that:

[ Kruesi] meets the claim limitations because the file is inaccessible (a determined inaccessibility) at the first node. The claim states "determining an inaccessibility" and this can reasonably be read in relation to the node.

As a matter of fact and law, it cannot. Independent claims 1, 19, and 30 explicitly specify that the *server* executes a *messaging session* based on "attempting retrieval of a subscriber announcement *for the messaging session from a messaging server* ... the subscriber announcement stored *in the messaging server*" and "determining an inaccessibility of the subscriber announcement *for the messaging session from the messaging server*". Independent claim 12 specifies *a server* configured for *initiating a messaging session* and that includes a first

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of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

<sup>4</sup>See footnote 1 *supra*



executable resource “configured for *attempting access to a messaging server ... the messaging server storing ... a subscriber announcement for a messaging session*”, and “the messaging application configured for playing *for the messaging session* an alternate subscriber announcement having an audible subscriber identifier, retrieved by the messaging application from the directory server as a second data file having a second size substantially smaller than the first size, *based on a determined inaccessibility of the subscriber announcement.*” Hence, the Examiner is deliberately disregarding these explicit claim limitations that *define* the nature of the determined inaccessibility (i.e., the inaccessibility of the subscriber announcement *stored in the messaging server for the messaging session*), in order to use Kruesi for the naked teaching of “a determined inaccessibility *at the first node*”.

Hence, the Examiner is disregarding the claimed determined inaccessibility of the subscriber announcement *stored in the messaging server for the messaging session*, and mischaracterizing the teachings of Kruesi et al., which teach away from this claimed feature by focusing on the system availability of the server:

An important characteristic of a messaging system is that it be highly reliable and able to quickly recover from system failures. This characteristic is generally referred to as system "availability." The present invention relates to a messaging system architecture that comprises multiple redundant messaging nodes in order to achieve high availability. In other words, the present invention was developed in the process of designing a messaging system that would *continue to provide access to messages stored in one disk file* (say, voice file 12a) *even while its corresponding host (server/NAP 10a) is inoperative*.

(Col. 3, lines 1-12).

Hence, if for some reason the server failed, then another server would need to be utilized; consequently, Kruesi et al. teaches that another server would be required, preventing use of an alternate subscriber announcement during the same messaging session as claimed.

In addition, Kruesi et al. explicitly specifies that the actual voice file 12a is always accessible, and that an alternate server is used to *retrieve* the voice file 12a from the same stored location. Hence, Kruesi et al. neither discloses nor suggests the claimed “determining an

inaccessibility of the subscriber announcement ... *from the messaging server*” as asserted by the Examiner.

Bates, Fuller and Kruesi teach that data is stored on a single disk. Hence, if stored subscriber announcement at that same storage location becomes inaccessible, the hypothetical combination would be unable to play any announcement, let alone an alternate subscriber announcement.

Hence, the hypothetical combination neither discloses nor suggests the claimed feature that a single server, *in response to* detecting an inaccessibility of a subscriber announcement *stored on a messaging server for a messaging session*, retrieves an audible subscriber identifier from a directory server and plays an *alternate subscriber announcement* for the messaging session including the audible subscriber identifier, as claimed.

Moreover, the hypothetical combination does not even address the problems identified by the inventors (and as specified in the Title of the Invention). As cited earlier, an evaluation of obviousness requires an evaluation of the problems addressed by the inventors. None of the problems addressed by the inventors have been addressed by the hypothetical combination, such that the inaccessibility of the subscriber announcement *stored in the messaging server* would result in the hypothetical combination being inoperable.


For these and other reasons, the §103 rejection should be withdrawn.

Conclusion

In view of the above, it is believed this application is in condition for allowance, and such a Notice is respectfully solicited.

To the extent necessary, Applicant petitions for an extension of time under 37 C.F.R. 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including any missing or insufficient fees under 37 C.F.R. 1.17(a), to Deposit Account No. 50-1130, under Order No. 95-461, and please credit any excess fees to such deposit account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'L. R. Turkevich', with a stylized flourish at the end.

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